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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,863	09/23/2003	Tomokazu Morita	243103US2SRD	1364

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EXAMINER
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WILLS, MONIQUE M

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 07/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/667,863	<b>Applicant(s)</b> MORITA ET AL.	
	<b>Examiner</b> Monique M. Wills	<b>Art Unit</b> 1745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statements filed September 23, 2003 has/have been received and complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. Accordingly, the information disclosure statement(s) is/are being considered by the examiner, and an initial copied is attached herewith.

### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4, 7, 8, 11-13 & 15-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1,5, 9, 14 & 15 of copending Application No. 11/175,294 Mortia U.S. Pub. 20060068287.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they contain common subject matter as follows:

Claims 1 & 5 of ' 294, embrace instant claim 1, by necessitating the following: a negative electrode active material for nonaqueous electrolyte battery, comprising: composite particles containing a silicon and a silicon oxide dispersed in a carbonaceous matrix; wherein the *silicon has a size of 2 to 50 nm*, and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder X-ray diffraction measurement of from 1.5 to 8.0°.

Claims 1 & 5 of ' 294, embrace instant claims 2 & 3, by necessitating the following: a negative electrode active material for nonaqueous electrolyte battery, comprising: composite particles containing a silicon and a silicon oxide dispersed in a carbonaceous matrix; wherein the *silicon has a size of 2 to 50*

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*nm*, and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder X-ray diffraction measurement of from 1.5 to 8.0°.

Claims 1 & 5 of ' 294, embrace instant claim 4, by necessitating the following: a negative electrode active material for nonaqueous electrolyte battery, comprising: composite particles containing a silicon and a silicon oxide dispersed in a carbonaceous matrix; wherein the silicon has a size of 2 to 50 nm, and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder *X-ray diffraction measurement of from 1.5 to 8.0°*.

Claims 1 & 5 of ' 294, embrace instant claims 7 & 8, by necessitating the following: a negative electrode active material for nonaqueous electrolyte battery, comprising: composite particles containing *a silicon and a silicon oxide* dispersed in a carbonaceous matrix; wherein the silicon has a size of 2 to 50 nm, and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder X-ray diffraction measurement of from 1.5 to 8.0°.

Claims 9, 14 & 15 of ' 294, embrace instant claim 11, by necessitating the following: a nonaqueous electrolyte battery comprising: a positive electrode; a negative electrode comprising a negative electrode active material opposite to the positive electrode, the material comprising: composite particles containing a silicon and a silicon oxide wherein the silicon has a size of 1 to 300nm, and dispersed in a carbonaceous matrix; and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder X-ray diffraction measurement of from 1.5 to 8.0.degree.

Claims 9, 14 & 15 of ' 294, embrace instant claims 12-13 & 15-17, by necessitating the following: a nonaqueous electrolyte battery comprising: a positive electrode; a negative electrode comprising a negative electrode active material opposite to the positive electrode, the material comprising: composite particles containing a silicon and a silicon oxide, wherein the silicon has a size of 2 to 50nm, and dispersed in a carbonaceous matrix; and a coating layer comprising a carbonaceous matrix coating on a surface of the composite particles, wherein the material has a half width of a diffraction peak of an Si (220) plane in a powder X-ray diffraction measurement of from 1.5 to 8.0.degree.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-17 rejected under 35 U.S.C. 102(e) as being anticipated by  
Aramata et al. U.S. Pub. 2003/0215711.

In re claims 1 & 11, Aramata teaches a nonaqueous electrolyte secondary battery (§ 1) comprising: a positive electrode (§ 54); a negative electrode containing a negative electrode active material including carbonaceous particles and a Si phase dispersed in the carbonaceous particles (§ 11); wherein average

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size of the Si phase is less than 100 nm (§ 11); and a nonaqueous electrolyte (§ 54). The limitation of claims 1 & 11, with respect to the negative electrode active material being  $1.5^\circ$  or more and  $8^\circ$  or less in a half width of a diffraction peak derived from (220) plane of silicon in powder X-ray diffraction, is considered an inherent characteristic of the prior art set forth, because Aramata teaches the same silicon/carbon anodic material set forth by Applicant. Support for this assertion is provided in MPEP 2112.01, “ [where] [p]roducts of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. See *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, since Aramata teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present.

With respect to claims 2 , 3 & 12, the Si phase is 1 to 100 nm (§ 11 & 32).

With respect to claims 4 & 13, limitation regarding the negative electrode active material having a half width between  $2^\circ$  and  $6^\circ$  , is considered an inherent characteristic of the prior art set forth, because Aramata teaches the same silicon/carbon anodic material set forth by Applicant. See *In re Spada* above.

In re claim 5, the molar ratio of silicon atoms to carbonaceous particles satisfy the formula  $0.2 \leq (X_1/X_2) \leq 2$ , is considered an inherent characteristic of



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the prior art set forth, because Aramata teaches the same anodic materials and particle sizes required by Applicant. See In re Spada above.

As to claims 7-8 & 15-16, the carbonaceous material further comprises particles in the silicon oxide phase (§ 11).

With respect to claims 9 & 17, the silicon oxide is in contact with the Si phase, because the crystallites of silicon are dispersed in silicon dioxide (§ 11).

With respect to claims 6 & 14, the limitation with respect to the carbonaceous particles size being from 5 microns to 100 microns, is considered an inherent property of the prior art set forth, because silicon composite power including carbon, has an average particle size of about 0.1 to 30 microns (§ 37). Therefore, the individual carbon particles have an average particle size less than 30 microns, embracing instant claims 6 & 14.

In re claim 10, the molar ratio of silicon atoms to Si phase satisfy the formula  $0.6 \leq (X_1/X_3) \leq 1.5$ , is considered an inherent characteristic of the prior art set forth, because Aramata teaches the same anodic materials and particle sizes required by Applicant. See In re Spada above.

Therefore, Aramata anticipates the instant claims.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Monique Wills whose telephone number is (571) 272-1309. The Examiner can normally be reached on Monday-Friday from 8:30am to 5:00 pm.

If attempts to reach Examiner by telephone are unsuccessful, the Examiner's supervisor, Patrick Ryan, may be reached at 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MW

6/27/06

**GREGG CANTELMO  
PRIMARY EXAMINER**

A handwritten signature in black ink, appearing to read "Gregg Cantelmo", is written over the printed name and title.

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